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08/528538

SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/528,538	09/14/96	KANEKO	N 35.61548

085514 MMC1/0228  
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EXAMINER

CUNEO, K

ART UNIT	PAPER NUMBER
2841	33

DATE MAILED: 02/28/01

This is a communication from the examiner in charge of your application.  
COMMISSIONER OF PATENTS AND TRADEMARKS

This application has been examined  Responsive to communication filed on 01/12/00  This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), 0 days from the date of this letter.  
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

1.  Notice of References Cited by Examiner, PTO-892.
2.  Notice of Draftsman's Patent Drawing Review, PTO-948.
3.  Notice of Art Cited by Applicant, PTO-1449.
4.  Notice of Informal Patent Application, PTO-152.
5.  Information on How to Effect Drawing Changes, PTO-1474.
6.

Part II SUMMARY OF ACTION

1.  Claims 1-3, 22, 23 are pending in the application.
2.  Claims \_\_\_\_\_ are withdrawn from consideration.
3.  Claims \_\_\_\_\_ are allowed.
4.  Claims 1-3, 22, 23 are rejected.
5.  Claims \_\_\_\_\_ are objected to.
6.  Claims \_\_\_\_\_ are subject to restriction or election requirement.
7.  This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.
8.  Formal drawings are required in response to this Office action.
9.  The corrected or substitute drawings have been received on \_\_\_\_\_. Under 37 C.F.R. 1.84 these drawings are  acceptable;  not acceptable (see explanation or Notice of Draftsman's Patent Drawing Review, PTO-948).
10.  The proposed additional or substitute sheet(s) of drawings, filed on \_\_\_\_\_, has (have) been  approved by the examiner;  disapproved by the examiner (see explanation).
11.  The proposed drawing correction, filed 3/16/98 has been  approved;  disapproved (see explanation).
12.  Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has  been received  not been received  been filed in parent application, serial no. \_\_\_\_\_; filed on \_\_\_\_\_.
13.  Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14.  Other

**DETAILED ACTION**

***Response to Request***

1. In response to the request for withdrawal of finality submitted 10/12/00, the finality of the previous office action is withdrawn and a new final action responding to the amendment of 7/20/00 follows. Claims 1-3, 22-23 are pending and are all clearly addressed in the grounds of rejection below. Applicant's arguments are all addressed in the response to argument section below.

***Treatment of Claims Based on Prior Art***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 23, 2-3 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yurek et al. (US 5545613, hereafter referred to as Yurek) and Shi et al. (Swagged Superconducting Wires, hereafter Shi) and Paranthaman et al. (Formation of Anisotropic Tl-1212, Tl-2212, Tl-1223 and Tl-2223 Particles using Aerosol Flow Reacted Powders, hereafter Paranthaman).

Yurek discloses a wire of a superconductive material where the grains of the material are compact and adhered together (sintered and compact) with silver (claim 2) filling the voids of the superconductive material in Example 7 prepared with the oxide-metal composite of Example 2, placed in the inside of a metal tube (conductive material) and composing a wire, column 3 at lines 12-23, 63-

67 and column 4 at lines 1-3.

Yurek discloses the claimed invention except the composition of the conductive material, thereby the higher melting point of the conductive material. It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to make the conductive material of the Yurek wire copper, gold or aluminum (claim 3), or an alloy thereof (claim 22), because it is well known in the superconducting arts to make the outer sheath of wires from these metals and their alloys, as evinced by Shi and Paranthaman. Selecting the conductive material as such necessarily makes the melting point of the conductive material higher than the solidified metallic material, silver (claim 23).

4. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yurek, as applied to claim 23 above, and Den et al. (US 5,512,538, hereafter referred to as Den).

Yurek discloses the claimed invention except for the superconducting oxide being Ln-Sr-Cu-M-O. Yurek does state that the invention is applicable to any superconducting oxide, column 2 at lines 43-44. Den discloses this type of superconducting oxide, reference the abstract.

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to use the superconductive oxide of Den to provide the superconductive material of Yurek, because this type of superconducting oxide is one of many oxides known in the art for making superconductive wires.

#### *Response to Arguments*

5. Applicant's arguments have been carefully reviewed, but are not persuasive. Applicant's first

argument (page 4) is that the rejection over Yurek is improper because a reference stating that use of copper, gold or aluminum as an outer tube is well known. Applicant challenges the commonness of gold, copper or aluminum as an outer tube, because a reference is not provided. First, applicant errs in asserting that the rejection is improper; a rejection based on common knowledge is proper even if a reference is not provided. Second, in challenging what examiner considers well known, applicant has not provided adequate information to raise reasonable doubt, on its face, regarding examiner's position. Applicant merely objects to the position without giving any reason. Third, in compliance with applicant's request, examiner has cited a couple of references in support of her position. As can be clearly seen, the knowledge is old in the art.

Applicant's second argument (top of page 5) is that Urek discloses a hollow tube and not a solid wire. Examiner notes that this argument is moot, because the claims do not recite that the wire is solid. Claim 23 recites that the "metallic material filling voids in said oxide superconductor." This is true of the prior art references: the metallic material fills the voids in the oxide superconductor. The claims make no mention of filling voids in the entire wire itself.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the solid wire) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicant's last argument (bottom of page 5) is that Den does not remedy the deficiencies of Yurek by teaching the metallic material or the outer coating. Examiner notes that this argument is spurious because Den is not relied upon for these teachings. Den is relied upon for the teaching of the

material of the oxide.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Applicant's arguments do not comply with 37 CFR 1.111<sup>®</sup> because they do not clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. Further, they do not show how the amendments avoid such references or objections.

The above constitutes a response to everyone of applicant's arguments.

6. MPEP 2144.03 states:

If the examiner adds a reference to the rejection in the next action after applicant's rebuttal, the newly cited reference, if it is added merely as evidence of the prior well known statement, does not result in a new issue and thus the action can potentially be made final. If no amendments are made to the claims, the examiner must not rely on any other teachings in the reference if the rejection is made final.

Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory

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period for reply expire later than SIX MONTHS from the date of this final action.

*Closing*

7. Any inquiries concerning this communication or earlier communications from the examiner should be directed to Examiner Kamand Cuneo at (703) 308-1233. Examiner Cuneo's supervisor is Examiner Jeffrey Gaffin whose telephone number is (703) 308-3301.



K. Cuneo  
Patent Examiner Group 2841  
February 26, 2001

